

REMARKS/ARGUMENTS

The Requirement correctly notes that PCT unity of invention rules apply to the subject application, which is a U.S. national phase application of a PCT application.

Unfortunately, the Requirement does not correctly apply the PCT unity of invention rules.

Applicants submit that, properly applied, the PCT unity of invention rules require all the claims in the case to be examined together.

As explained at MPEP § 1893.03(d), claims possess unity of invention if they are so linked as to form a single general inventive concept. Section 1893.03(d) states, at MPEP page 1800-156 (8th ed., Rev.1, Feb. 2003):

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical feature is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

Thus, a group of inventions are considered to share unity of invention when there is a common special technical feature. A special technical feature, in turn, is the contribution which each invention, considered as a whole, makes over the prior art. If the inventions share a special technical feature, they share unity of invention and it is not appropriate to impose a lack of unity requirement under § 1893.03(d). That is the case here.

As is evident from an examination of the claims, the claims relate to the discovery that farnesyltransferase is a mechanism of regulating guard cells in plants and that inhibiting farnesyltransferase renders plants more resistant to drought. Thus, all the claims relate to the contribution which each invention, considered as a whole, makes over the prior art. The claims therefore share the same technical feature, and should be considered together. The Requirement should be withdrawn and the claims considered together.

The Requirement does not find otherwise. Instead, it merely contends that the groups do not share the same technical feature because one is directed to expression of an inhibitor, one is an antisense inhibitor, etc. In other words, the Requirement merely applies normal U.S. restriction practice of dividing the claims into groups based on the type of claims. It does not explain what contribution the invention, considered as a whole, makes over the art, or why the groups into which it divides the claims fail to share that contribution. It therefore fails to apply the correct analysis. Not surprisingly, it therefore arrives at an incorrect result.

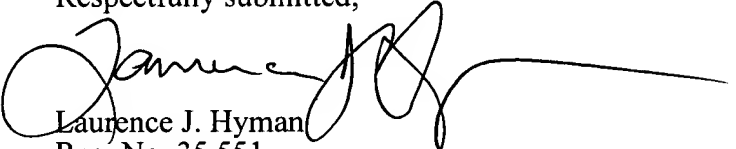
As an additional matter, Applicants respectfully note that the claims should be recombined for a second, independent reason. As the Examiner is aware, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803. According to the MPEP, there are two criteria for a proper restriction requirement: the inventions must be distinct and there must be a serious burden on the examiner. *Id.* The MPEP provides that a prima facie showing may be made if the examiner shows either separate classification, separate status in the art, or a different field of search. *Id.* In the present case, the Restriction does not even assert, let alone show, that there would be a serious burden on the Examiner to examine the claims together. The Requirement therefore fails to present a prima facie case of a serious burden, and the restriction between the groups cannot be sustained. The groups should be rejoined.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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